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Remarks:

*Amendments to the claims:*

Claims 1, 2, 10-13, 15, 17 and 19 are pending in this application. In this paper, claims 1, 2, 10-13, 15, 17 and 19 are amended, and claims 14, 16 and 18 are canceled. Claim 17 is amended to address a claim objection.

No new matter is added to the application by this Amendment.

*Allowable Subject Matter:*

Applicants note with appreciation that claim 17 has been identified by the Examiner as containing allowable subject matter if re-written to overcome the object discussed below.

*Regarding the objection of claim 17:*

Applicants respectfully traverse the objection of the foregoing claim.

In response to the objection, claim 17 is amended to remove the formula 1b from the claim and move the formula 1c to follow the statement "a compound of formula 1c" as requested by the Patent Office. Applicants submit that the amendments to claim 17 overcome the claim objection.

Applicants respectfully request withdrawal of the objection to claim 17.

*Regarding the rejection of claims 1, 2 and 10-14 under 35 USC 102(b) as allegedly being anticipated by Freerksen et al. (Journal of Organic Chemistry, 1983, vol. 48, pages 4087-4096) (hereinafter "Freerksen"):*

Applicants traverse the Examiner's rejection of claims 1, 2 and 10-14 as allegedly being anticipated by Freerksen.

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Prior to discussing the relative merits of the Examiner's rejection, the applicant points out that unpatentability based on "anticipation" type rejection under 35 USC 102(b) requires that the invention is not in fact new. See *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack of novelty (often called 'anticipation') requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee"). Anticipation requires that a *single reference* [emphasis added] describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. See, *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The principle of "inherency," in the law of anticipation, requires that any information missing from the reference would nonetheless be known to be present in the subject matter of the reference, when viewed by persons experienced in the field of the invention. However, "anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation, [or the reference] cannot inherently anticipate the claims." *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 [62 USPQ2d 1865] (Fed. Cir. 2002); *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency).

Thus when a claim limitation is not explicitly set forth in a reference, evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co.*, 948 F.2d at 1268. It is not sufficient if a material element or limitation is "merely probably or possibly present" in the prior art. *Trintec Indus., Inc. v.*

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*Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002). See also, *W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation "cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references"); *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

With regards to claims 1 and 2, the Patent Office alleges that Freerksen discloses 1-cyclooctene-1-enylethanone, a compound according to formula I where X is carbonyl, R is methyl, and the double bond is between C1 and C2. The Patent Office acknowledges that Freerksen fails to teach that the compound is usable as a fragrance. However, the Patent Office alleges that the compounds of Freerksen will have a vapor pressure and will inherently act as a fragrance. Applicants respectfully disagree with these allegations.

Nowhere does Freerksen disclose a composition comprising a compound of formula I as a fragrance as required by amended claim 1. Freerksen fails to teach or suggest that 1-cyclooct-1-enylethanone is usable as a fragrance as alleged by the Patent Office. A compound is not inherently suitable as a fragrance ingredient because the compound is known in the art to have a vapor pressure as alleged by the Patent Office. One of ordinary skill in the art would not turn to Freerksen to find a suitable fragrance compound, namely, 1-cyclooct-1-enylethanone merely because the compound is known in the art to have a vapor pressure. The fact that the compound of Freerksen has a vapor pressure does not teach or suggest that the compound is suitable for use as a fragrance as recited in claim 1.

For claims 10-14, the Patent Office alleges that Freerksen teaches the compound in a solution with hexamethylphosphoramide (HMPA) which is a product and that the teachings of Freerksen et al. satisfies Applicants' definition of a fragrance application,

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as on comprising a product and an odorant, such as 1-cyclooct-1-enylethanone. Applicants respectfully disagree with these allegations.

In view of the cancelation of claim 14, this rejection is moot with respect to that claim.

Freerksen teaches that HMPA is used as a co-solvent. However, HMPA is known to be a carcinogen. Carcinogens are not suitable to satisfy Applicants definition of a fragrance as alleged by the Patent Office. One of ordinary skill in the art would not turn to Freerksen to use a known carcinogen, such as HMPA, in a fragrance application. Thus, Applicants submit that the HMPA product of Freerksen does not teach or suggest a fragrance application that is selected from the group consisting of fine perfumery, household products, laundry products, body care products and cosmetics as required by amended claims 10-13.

Because the features of independent claim 1 are neither taught nor suggested by Freerksen, Freerksen cannot anticipate, and would not have rendered obvious, the features specifically defined in claim 1 and its dependent claims.

For at least these reasons, claims 1, 2 and 10-13 are patentably distinct from and/or non-obvious in view of Freerksen. Reconsideration and withdrawal of the rejections of the claims under 35 U.S.C. §102(b) are respectfully requested.

*Regarding the rejection of claims 18 and 19 under 35 USC 102(b) as allegedly being anticipated by Dixon et al. (Journal of Chemical and Engineering Data, Vol. 20, No. 1, 1975, pages 123 and 124) (hereinafter "Dixon"):*

Applicants traverse the Examiner's rejection of claims 18 and 19 as allegedly being anticipated by Dixon.

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The Patent Office alleges that Dixon teaches each and every feature recited in claims 18 and 19. Specifically, the Patent Office alleges that Dixon discloses the compound 5-acetylclooctene (1-cyclooct-4-enylethanone), a compound of formula I, where X is carbonyl, R is methyl, and a double bond between C4 and C5. Applicants respectfully disagree with these allegations.

In view of the cancelation of claim 18, this rejection is moot with respect to that claim.

Nowhere does Dixon disclose a fragrance comprising a compound selected from 1-cyclooct-3-enyl-2-methylpropan-1-one, 1-cyclooct-3-enylpropan-1-ol, 1-cyclooctyl-2-methylpropanone and 1-cyclooctyl-2-methylpropanol as required by amended claim 19.

Because the features of independent claim 19 are neither taught nor suggested by Dixon, Dixon cannot anticipate, and would not have rendered obvious, the features specifically defined in claim 19.

For at least these reasons, claim 19 is patentably distinct from and/or non-obvious in view of Dixon. Reconsideration and withdrawal of the rejections of the claims under 35 U.S.C. §102(b) are respectfully requested.

*Regarding the rejection of claims 15 and 16 under 35 USC 103(a) as allegedly being unpatentable over Freerksen:*

Applicants traverse the Examiner's rejection of claims 15 and 16 as allegedly being unpatentable over Freerksen.

Prior to discussing the merits of the Patent Office's position, the undersigned reminds the Patent Office that the determination of obviousness under § 103(a) requires consideration of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 [148 USPQ 459] (1966): (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary

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considerations, if any, of nonobviousness. *McNeil-PPC, Inc. v. L. Perrigo Co.*, 337 F.3d 1362, 1368, 67 USPQ2d 1649, 1653 (Fed. Cir. 2003). See also *KSR International Co. v. Teleflex Inc.*, 82 USPQ2D 1385 (U.S. 2007).

A methodology for the analysis of obviousness was set out in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

It must also be shown that one having ordinary skill in the art would reasonably have expected any proposed changes to a prior art reference would have been successful. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207, 18 USPQ2d 1016, 1022 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

The Patent Office alleges that Freerksen teaches a method of making comprising a step of synthesis of the compound 1-cyclooct-1-enylethanone, a compound according to formula I where X is carbonyl, R is methyl, and the double bond is between C1 and C2, in the presence of HMPA. The Patent Office also alleges that HMPA is a product and the teaching of Freerksen satisfies Applicant's definition of a fragrance application, as one comprising a product and an odorant, such as 1-cyclooct-1-enylethanone. Applicants respectfully disagree with these allegation by the Patent Office.

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In view of the cancelation of claim 16, this rejection is moot with respect to that claim.

As discussed above with respect to claim 1, Freerksen fails to teach or suggest a composition comprising a compound of formula I as a fragrance as recited in claim 1, from which claim 15 depends. Moreover, Freerksen fails to teach or suggest the method according to amended claim 15 wherein the fragrance application is selected from the group consisting of fine perfumery, household products, laundry products, body care products and cosmetics.

Because these features of independent claim 1 are not taught or suggested by Freerksen, the reference would not have rendered the features of claim 15 obvious to one of ordinary skill in the art.

In view of the foregoing, reconsideration and withdrawal of this rejection are respectfully requested.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience. The early issuance of a *Notice of Allowability* is solicited.

**PETITION FOR A ONE-MONTH EXTENSION OF TIME**

Applicants respectfully petition for a one-month extension of time in order to permit for the timely entry of this response. The Commissioner is hereby authorized to charge the fee to Deposit Account No. 14-1263 with respect to this petition.

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**CONDITIONAL AUTHORIZATION FOR FEES**

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully Submitted;

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30 January 2009

Date:

**CERTIFICATE OF TELEFAX TRANSMISSION UNDER 37 CFR 1.8**

I certify that this document, and any attachments thereto, addressed to the:  
"Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" is being  
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Allyson Ross

Allyson Ross

30 Jan 2009

Date

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